



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/108,715

07/01/1998

KOICHI NAGATA

05058/72201

2753

24367

7590

05/25/2004

SIDLEY AUSTIN BROWN & WOOD LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS, TX 75201

EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 05/25/2004

JH

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/108,715

Applicant(s)

NAGATA, KOICHI

Examiner

Jerome Grant II

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

JEROME GRANT II
PRIMARY EXAMINER

Detailed Action

1. The following is a quotation of the appropriate paragraphs of 35 U.S. C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon.

With respect to claim 1, Gordon teaches a facsimile apparatus (shown in figure 1) which is capable of receiving confidential image data (see cols. 11 and 12, from an origin and which is provided with a confidential 1 reception function, comprising: a memory which stores received confidential image data (see mass memory 157 in figure 3); notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it.

Art Unit: 2626

Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see cot. 11, lines 50-60. Note that a Notification is sent to the designee concerning the secure document. There is a notice to the original of the fax that messages have been delivered (but not retrieved yet) since the notification is prior to the user having a chance to retrieve the message. Gordon teaches wherein said notification is transmitted if the received confidential image data has not been retrieved from the memory within a predetermined period of time. This is the time after notification given to designee and time required to access the secured document.

With respect to claims 2, 12, and 14 see cot. 12, lines 50-55. With respect to claims 3 and 10, see cot. 13, lines 48-57. With respect to claim 4, the address information is the mailbox number. With respect to claim 5, see cot. 11, lines 50-60. The notification includes posting the report or delivery correspondence. With respect to claim 6, see cot. 8, lines 52-56. With respect to claim 7, see cot. 3, lines 50-53. With respect to claim 9, see cot. 13.

With respect to claim 11, Gordon teaches a facsimile apparatus provided with a confidential reception function, comprising: a memory 67 which stores received confidential image data; an output means (user at a remote terminal or key pad who has access to the user mailbox number) for outputting stored confidential image data from said memory in response to input of a password by an operator; a determination means

Art Unit: 2626

(general service control 50) for determining whether confidential image data has been outputted by the output means within a predetermined time after reception of confidential image data; notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it. Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see col. 11, lines 50-60. Note that a Notification is sent to the designee concerning the secure document. There is a notice to the original of the fax that messages have been delivered (but not retrieved yet) since the notification is prior to the user having a chance to retrieve the message.. Gordon teaches wherein said notification is transmitted if the received confidential image data has

Application/Control Number: 09/108,715 Page 5

Art Unit: 2624

not been retrieved from the memory within a predetermined period of time. This is the time after notification given to designee and time required to access the secured document.

With respect to claim 13, Gordon teaches a managing method for managing a confidential received image in a facsimile apparatus, the facsimile apparatus being provided with a confidential reception function, the method comprising the steps of:

Art Unit: 2626

receiving confidentially image data (SAFF 8 or 18) and storing the received image data in a memory 67 in the facsimile apparatus; destination SAFF for monitoring whether the stored confidential image data has been outputted within a predetermined time after reception. of the confidential image data, via the outside user accessing the system with the correct mailbox number, transmitting notification (answer function of SAFF 18, see col. 13, lines 48-57) which indicates if output has not occurred, when outputting of the confidential image data has not occurred within the predetermined time; detecting proper completion of transmission of the notification (user SAFF 8 and 18) and deleting the confidential image data from the memory in response to a detection of the proper completion of transmission of the notification, see col. 11, lines 50-60.

With respect to claim 15, Gordon teaches a facsimile apparatus capable of receiving confidential image data from a source, the facsimile apparatus comprising: a memory 67 capable of storing received confidential image data; a notification transmitter file 90 adapted to transmit a notification to the source; a confirmation apparatus (SAFF 8 and 18) adapted to confirm receipt of the notification by the source; and a deleting apparatus adapted to delete stored confidential image data (col. 11, lines 50-60); wherein the notification transmitter 90 transmits the notification after a predetermined time if the notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also

Art Unit: 2626

cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it. Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see col. 11, lines 50-60.

2.

Examiner's Remarks

With respect to applicant's remarks found at the bottom of page 3 and bridging page 4, applicant contends that Gordon does not teach a transmission of a status report indicating the image has not been retrieved from the memory.

The examiner respectfully disagrees. Col. 7, lines 29-31 teaches that incoming calls are stored in a Mass Storage Unit 67. Col. 7, lines 32-40 indicates that the security status of the document is ascertained. In other words, the document that has been received is determined to be a secured document or not. Col. 11, indicates the situation when there are too many messages in a queue. Lines 18-26 of col. 11, indicated that a queue report is sent to a destination fax. This queue report indicates all of the messages that awaits the destination fax. The messages that have been stored in the queue and have not been transmitted to the destination fax machine may be identified as such in the "Queue Report", see line 20. Hence, it is the un-transmitted messages that have not been retrieved from the memory which may be transmitted when the un-

transmitted messages are advanced ahead of the existing queue priority. Now that the un-transmitted messages are ahead of the queue, the messages are queued for transmission to the destination fax machine. Queue reports and status reports notify the operator if messages that could be secured have been transmitted or not.

Applicant further argues in the first full paragraph of page 4, that Gordon does not provide deleting the confidential image data from the memory in response to a completion of the transmission of notification. The examiner strongly disagrees. The deletion of confidential information is taught clearly at col. 11, lines 50-60. The examiner is careful to note that Applicant has not commented on this portion of the Gordon reference relied upon by the examiner.

At the bottom of page 4 of the Applicant's remarks, Applicant reiterates the argument presented with regard to claim 1. In response, thereto, the examiner contends the limitation has been addressed above and is clearly taught by Gordon.

At page 5, Applicant contends that claim 13 is distinguished over Gordon in that it does not teach notification that output has not occurred when the confidential message has not been output in a predetermined time frame. The examiner strongly disagrees with this assertion, and notes that applicant has not provided any proof to this assertion in connection with the sections of Gordon relied upon in the examiner's rejection to this claim.

At page 5, applicant contends that claim 15 is distinguished over Gordon in that it does not teach a status message back to the originator when the fax message is received by the SAFF system. The examiner strongly disagrees with applicant's contention. The features have been thoroughly explained in the rejection to claim 15. Applicant has not set forth any proof in support of his contention, and has not shown how the cols. and line numbers relied upon does not meet the claimed features.

3.

Examiner's Remarks

With respect to applicant's remarks submitted after the Final Rejection, at page 2, applicant argues that the Gordon reference does not teach deleting a confidential transmission when notification of the transmission has been detected by the notification data transmission means.

The examiner has identified the notification transmission means as file 90 (middle of page 2 of the office action). The examiner notes that in applicant's response, no mention is made of file 90, nor does applicant mention how or why file 90 could not or (lid not perform the function of the notification data transmission means. Furthermore, at line 6 of the examiner's office action, the examiner specifically relied upon col. 8, lines

Art Unit: 2626

I-10 and col. 9, lines 35-40 of the Gordon reference as a teaching for the notification of the data transmission means. Yet, applicant had not even referred to these sections, which examiner relied upon as support, to refute the examiner's rejection. Instead, applicant relied upon some irrelevant and extraneous section of the reference in support of a position the examiner did not advance. Applicant's method of argument is not persuasive in that applicant has not answered the examiner's rejection with respect to the limitations and sections of Gordon specifically relied upon.

Application/Control Number: 09/108,715 Page 3

Art Unit: 2626

At page 4, last paragraph, applicant alleges that "Gordon does not disclose or suggest that image data is deleted in response to the completion of transmission of notification data to the origin." Applicant's contention is strongly traversed by the examiner.

Gordon teaches an original transmission SAFF 8 and a destination SAFF 18. Each SAFF contains a Host which records the arrival time and other pertinent information about the fax message in a Call Status file 90 (see col. 8, lines 5-7). Lines 7-10 of col. 8, state that, "... the host... sends a status update back to the originating SAFE"

Art Unit: 2626

Consider the teaching of Gordon at col. 8, lines 52-63. Here, a document has been sent to the SAFF 18 but has not been successfully transmitted to the destination fax machine 28. Lines 52-55 indicate that a delivery report is sent to the originating machine 1 through element 9 of SAFF 8. In response to the notification to the originating fax machine, an operator gains access to the overall system to instruct the host computer at the destination side (SAFF 18) as to how to handle the received document. Col. 8, line: 62 specifically states that the document can be deleted. Hence, the document is deleted after a notification is sent to it by the Host of SAFF 18. This is clearly the limitation of claim 1, which is clearly anticipated by Gordon.

Application/Control Number: 09/108,715 Page 4

Art Unit: 2626

In response to applicant's arguments at the top of page 5., it is alleged that claims 2-10 are allowed because claim 1 is allowed. Applicant's argument is incorrect based upon the explanation provided above.

In the middle of page 5, applicant alleges that claims 11 and 12 are allowed for the reason that Gordon does not teach upon a detection of proper completion of transmission of notification indicating that confidential image data has not been outputted from the memory.

Art Unit: 2626

The examiner notes that applicant's statement here is a mere allegation. Applicant's contention is unfounded and unsupported in that no proof is set forth in support for applicant's contention. The examiner has set forth an entire page worth of arguments and contentions, setting forth sections in the Gordon reference and specific elements, clearly labeled. Yet, applicant has not shown how or why the specific elements proffered by the examiner do not address the claimed limitation. The examiner has clearly and convincingly shown through analysis, with column and line numbers and element labels how the claim limitations have been met. Applicant has not even addressed the examiner's rejection in view of the limitations relied upon.

Applicant's mere allegation without specific proof is clear and convincing evidence that the rejection is proper and that claims 11 and 12 are clearly anticipated by Gordon.

With respect to claim 13, applicant states that Gordon does not teach deleting confidential image data from the memory in response to a detection of the proper completion of transmission of the notification.

The examiner notes again that applicant's statement is a mere allegation. No proof is proffered for the position taken by applicant. However, the examiner notes that applicant's argument is similar to that submitted in response to claim 1. For at least the same reasons supporting the rejection of claim 1 found above, the rejection to claim 13 is sustained.

Art Unit: 2626

With regard to claim 15, applicant reiterates the arguments presented in claims 1 and 13. It is noted that no proof for applicant's position is proffered. Applicant's contention regarding the allowance of claim 15 is traversed in view of the examiner's position supported above and by the rejection submitted April 7, 2003.

4.

Action Made Final

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.129(a). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under 37 CFR 1.129(a). See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2626

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II



JEROME GRANT II
PRIMARY EXAMINER